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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/586,754

07/21/2006

Tamotsu Nagamatsu

8007-1113

7978

466 7590 06/26/2008

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EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

06/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/586,754	NAGAMATSU ET AL.	
	Examiner	Art Unit	
	Rabon Sergent	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/21/06, 10/25/06</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1796

1. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, the use of the word, “type”, so extends the scope of the language to which it is appended that the claims are rendered objectionably indefinite. *Ex parte Copenhaver*, 109 USPQ 118.

Secondly, the use of the language, “essentially comprising”, renders the claims indefinite, because the significance or meaning of the language cannot be ascertained. Within U.S. patent practice, “essentially comprising” is neither defined nor considered acceptable transitional language.

Thirdly, with respect to claims 4, 8, and 9, the claimed range, 0.50 to 2.0.3, is incomprehensible. No meaningful limitation whatsoever can be ascribed to the claims. Furthermore, the “ratio” has not been clearly set forth as such. Accordingly, it is unclear if “0.50:2.0.3” or “0.50:1 to 2.0.3:1” is contemplated.

Fourthly, with respect to claims 5 and 10-12, no basis has been set forth for the claimed mol%. It is unclear if the percent value is based upon component (c) or some other entity.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Melchiors et al. ('254).

Melchiors et al. disclose aqueous polyurethane coating compositions derived from diisocyanate, polycarbonate diol having a molecular weight of 400 to 6,000 Da, dihydroxycarboxylic acid, an alkanolamine, a diamine, and a carboxylic acid neutralizing agent. See abstract; column 2, lines 10+; column 4, lines 12-42; column 5, lines 43-52 and 57+; column 6, lines 13-24 and 27-49; and column 7, lines 16-40.

4. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Muller et al. ('195 or '885).

Muller et al. disclose aqueous polyurethane coating compositions derived from diisocyanate, polycarbonate diol having a preferred molecular weight of 700 to 4,000, dihydroxycarboxylic acid, a diamine, and a monofunctional chain terminating agent, such as an aminoalcohol (alkanolamine), and a carboxylic acid neutralizing agent. See abstract; column 3, lines 54+; column 4; column 5, lines 36-45 and 65+; column 6, lines 1-22 and 31-48, within Muller et al. ('195). See abstract; column 3, lines 30+; column 4, lines 1-32 and 55+; and column 5, lines 1-12 and 19-36, within Muller et al. ('885).

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

/Rabon Sergent/
Primary Examiner, Art Unit 1796

R. Sergent
June 21, 2008